

10/648,702
January 4, 2005
Reply to Office Action of 10/05/2004

Via Facsimile

Remarks

This amendment is in response to the October 5th, 2004 Office Action. Applicant respectfully traverses Examiner's rejections of claims 1-20 in light of the above amendments, appended affidavit, and the following remarks:

Rejection of claims under/in view of Kawalec

The Examiner rejected claims 1-6, 15-16 and 19-20 as being anticipated by Kawalec. Kawalec is a plate that is attached to the front surface of a tree, see page 1, paragraph 3. In light of the above amendments, all of Applicant's pending claims involves the insertion of a tag into the tree, and not the attachment of a plate onto the surface of a tree.

The Examiner also rejected other claims using Kawalec in combination with other art. Applicant re-asserts the above argument for any 103(a) rejection made using Kawalec.

Rejection of claims using the "PFC" reference

The Examiner rejected some applicant's claims using the "PFC" reference, although some of the rejections were not explicit. Although this reference is probably non-enabling, Applicant traverses these rejections based on the 131 affidavit swearing behind an invention date that pre-dates this reference, namely that applicant conception of the invention dates to at least January 28th, 2002.

Rejection of claim 14 under 103(a) in view of Kawalec and Cybulski '089

Applicant traverses the Examiner's assertion that a RFID scanner mounted to a forklift for reading pallets is comparable to RFID scanners mounted on vehicles (such as lumber trucks), lumber yard entrances, lumber yard buildings or truck inspection stations that read RFID tags cut trees.

Applicant adds that the arguments made against Kawalec above are also applicable to claim 14.

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Rejection of claim 17 under 103(a) in view of Kawalec and Shafer '491

Although the appended affidavit pre-dates the priority of Shafer, applicant concedes that active and passive tags were known in the art prior to Applicant's invention and that the use of an active tag is not *by itself* novel. However, in light of the arguments made over Kawalec above, applicant believes that claim 17 is patentable.

Priority of Carlson and Pickett

The Examiner noted in his conclusion that Carlson and Pickett may be prior art references. Based on the submitted affidavit, Applicant believes that this is no longer the case.

Comments on Claim 3

The Examiner noted the limitation "minimal visual mark" in claim 3 is somewhat subjective. Applicant wishes to explain the need for a subjective claims and the intentions behind it. As is apparent from a reading of the specification, one of the embodiments of applicant's invention is the use of inserted RFID tags to counter wood theft.

By inserting an RFID tag into a tree and leaving a minimal visual mark, potential thieves are unlikely to find and tamper with the tag. Almost any insertion of a tag into a tree will, objectively, leave some visual mark, however the extent one needs to go to to find the mark can become subjectively absurd. Also, since the tree is a living organism, the mark can be reduced over time. Therefore the term "minimal visual mark" can be characterized as "unlikely to be seen," or "difficult to see with the naked eye," or other somewhat subjective limitations that are unfortunately necessary when claiming something that is being hidden.

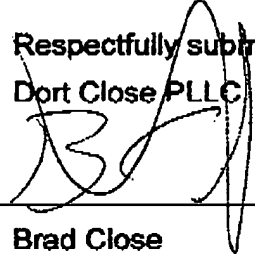
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In view of the above amendments, remarks and submitted affidavit,
applicant respectfully requests that a timely Notice of Allowance be issued in this
case.

Respectfully submitted,
Dort Close PLLC

by



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recognition under 10.9(b)
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